

Appl. No. 09/699,626
Amdt. dated September 16, 2005
Reply to Office Action of June 16, 2005

REMARKS

Applicant has carefully reviewed the Office Action mailed on June 16, 2005. Favorable reconsideration is respectfully requested in light of the following comments. Claims 37-38 are pending.

Applicant respectfully traverses the Examiner's rejection of claims 37 and 38 under 35 U.S.C. §103(a) as unpatentable over Becker et al., U.S. Patent No. 5,021,043, in view of Gambale et al., U.S. Patent No. 4,922,924, and further in view of Tanabe et al., U.S. Patent No. 4,838,879. Applicant respectfully asserts that the Examiner has failed to establish a proper *prima facie* obviousness rejection.

In particular, one of the requirements of a *prima facie* obviousness rejection is that one of ordinary skill in the art would be motivated to combine or modify the cited references as suggested by the Examiner. In the pending rejection, Applicant asserts that at least this requirement of a *prima facie* obviousness rejection is lacking.

The Examiner notes that Becker et al. fail to teach a radiopaque coil tip, but asserts that Gambale et al. teach the missing element. This is incorrect, as Becker et al. disclose a dilation catheter adapted for dilating the lacrimal system, which involves tear drainage from a person's eyes. Becker et al. disclose, as noted by the Examiner, "visually perceivable markers" that can be visually seen through a translucent balloon. In use, one of these visually perceivable markers will be visually aligned with, for example, an opening through which Becker et al.'s dilation catheter is inserted. Visual alignment, as used by Becker et al., does not appear to include fluoroscopic techniques. Becker et al. do not disclose or suggest the use of techniques in which a radiopaque coil tip would have any advantage or function. Thus, while a radiopaque coil tip may be useful in the techniques to which Gambale et al. are directed, an individual of even ordinary skill in the art would not be motivated to modify the teachings of Becker et al. to include a radiopaque coil tip.

Moreover, neither Becker et al. nor Gambale et al. teach the use of radiopaque markers. The Examiner has asserted that it would be obvious, based upon the teachings of Tanabe et al., to modify the device allegedly taught by the asserted combination of Becker et al. and Gambale et al. to include radiopaque markers. This is incorrect, as discussed above. Becker et al. describes a technique, and thus equipment for such a technique, that does not rely upon, or even suggest,

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the use of radiopacity. Therefore, one of ordinary skill in the art would not be motivated to attempt to combine these three references as suggested by the Examiner.

Thus, the *prima facie* obviousness rejection is flawed and should be withdrawn. Applicant does not concede that the Examiner has established either of the other requirements of a *prima facie* obviousness rejection, i.e., meeting all of the claimed elements and a reasonable expectation of success.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

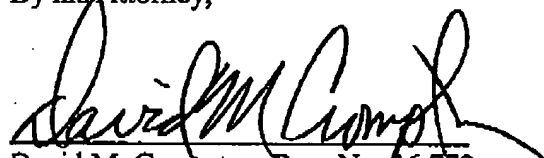
Respectfully submitted,

Daniel J. Sullivan

By his Attorney,

Date: _____

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